

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number: 04838-077001
	Application Number 10/720,742	Filed November 24, 2003
	First Named Inventor Lawrence W. Yonge III et al.	
	Art Unit 2141	Examiner Chirag R. Patel

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).  
 Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
 See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record 56,569  
 (Reg. No.)

☐ attorney or agent acting under 37 CFR 1.34.  
 Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

\_\_\_\_\_  
 Signature

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 Typed or printed name

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 Telephone number

November 1, 2006  
 Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ Total of 1 form is submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Lawrence W. Yonge III et al.      Art Unit : 2141  
Serial No. : 10/720,742      Examiner : Chirag R. Patel  
Filed : November 24, 2003      Conf. No. : 2741  
Title : MEDIUM ACCESS CONTROL LAYER THAT ENCAPSULATES DATA  
FROM A PLURALITY OF RECEIVED DATA UNITS INTO A PLURALITY OF  
INDEPENDENTLY TRANSMITTABLE BLOCKS

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005 - New Pre-Appeal Brief Conference Pilot Program (extended January 10, 2006), a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of Examiners is requested because the rejections of record are clearly not proper and are without basis, in view of a clear legal or factual deficiency in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Claims 1-68 are pending, of which claims 1, 49, and 57 are independent claims. All amendments have been entered. All of the claims stand rejected, including the independent claims, as follows:

- Claims 1 and 57 stand rejected under 35 U.S.C. 102(b) as anticipated by Yi (U.S. 2002/0001314).
- Claim 49 stands rejected under 35 U.S.C. 103(a) as unpatentable over Yi in view of Rakib (U.S. 2002/0015423).

Applicant specifically requests the panel to review the following issues:

1. The Examiner has made a clear error in providing a valid factual basis to support a *prima facie* rejection of claim 1.
2. The Examiner has made a clear error in providing a valid factual basis to support a *prima facie* rejection of claim 49.

3. The Examiner has made a clear error in providing a valid factual basis to support a *prima facie* rejection of claim 57.

Each of these issues is discussed in greater detail below. Applicants reserve the right to expand these issues and/or present new issues when filing their appeal brief, including issues raised in previous replies filed on December 22, 2005, June 21, 2006, and September 8, 2006, each of which is incorporated herein by reference.

Discussion of Issues:

1. The Examiner has made a clear error in providing a valid factual basis to support a *prima facie* rejection of claim 1.

The Examiner has made a clear error in providing a valid factual basis to support the 35 USC 102(b) rejection of claim 1. In view of this error, Yi fails to disclose all limitations of independent claim 1.

Yi does not disclose at least "dividing the encapsulated content into a plurality of pieces ... at least some of the low level data units each containing a plurality of the pieces," as recited by independent claim 1.

The Examiner identified in the Office Action mailed February 22, 2006, and in the Office Action mailed August 2, 2006, the description in Yi of "a method of generating PDUs in a radio link control layer [that] includes producing a payload unit by segmenting and/or concatenating one or more service data units received from a higher layer, generating a first PDU which includes a sequence number corresponding to the payload unit and a second PDU which includes the payload unit, and transmitting the first and second PDUs to a lower layer" (paragraph [0014]) as disclosing the recited "dividing the encapsulated content into a plurality of pieces."

In the Office Action mailed August 2, 2006, the Examiner goes on to say that "Per [0015], the PDU units contains a payload unit and a MAC header and reads on the claim limitations 'at least some of the low level data units each containing a plurality of pieces' since each PDU contains multiple pieces, in this case the payload unit and MAC header."

Applicant pointed out in the reply mailed September 8, 2006, that claim 1 requires not just that at least some of the low level data units each contain "a plurality of pieces," but that at least some of the low level data units each contain a plurality of the pieces into which the encapsulated content was divided. Since only the payload unit and not the MAC header corresponds to a piece produced "by segmenting and/or concatenating one or more service data units received from a higher layer," the MAC header does not correspond to one of the claimed pieces. Thus, there is no factual basis for asserting that the PDU units correspond to low level data units each containing a plurality of the pieces.

Applicant further pointed out that a proper anticipation rejection "requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983) Thus, it is improper to base an anticipation rejection on the subject matter identified by the Examiner since it does not disclose all claimed elements arranged as in the claim.

In an initial Advisory Action mailed September 25, 2006, the Examiner made an error in quoting the claim language as requiring low level data units "containing one or more of the plurality of pieces." After the Applicant's representative called the Examiner to point out this error and request that Applicant's argument be considered, the Examiner issued a second Advisory action, a copy of which was faxed to the Applicant's representative on October 24, 2006.

In this second Advisory Action, the Examiner quoted paragraphs [0014] and [0026] of Yi and asserted that: "The SN PDU contains the SN (sequence number) and the E (extension) field. The other independent PDU contains the length indicator (LI) and the E (extension) field. This reads on claim limitations 'at least some of the low level data units' (the PDU) 'each containing a plurality of the pieces' (SN, E, LI)." While the Examiner corrected the misquote of claim 1, the Examiner still failed to provide any factual basis for asserting that Yi discloses that "at least some of the low level data units each [contain] a plurality of the pieces [into which the encapsulated content was divided]." None of the "sequence number," the "extension," or the

"length indicator" remedy the shortcoming of the "MAC header" in providing a valid factual basis for a proper anticipation rejection.

Applicant submits that the Examiner has made a clear error in rejecting claim 1, and that this error is not a matter of interpretation of the claims or prior art teachings, but instead a matter of the existence of a valid factual basis for asserting that the prior art discloses all claimed elements arranged as in the claim.

2. The Examiner has made a clear error in providing a valid factual basis to support a *prima facie* rejection of claim 49.

The Examiner has made a clear error in providing a valid factual basis to support the 35 USC 103(a) rejection of claim 49. In view of this error, no valid combination of Yi and Rakib teach or suggest all limitations of independent claim 49.

Yi does not teach or suggest at least "dividing the encapsulated content into a plurality of pieces, with at least some of the low level data units each containing a plurality of the pieces," as recited by independent claim 49. Furthermore, no proper combination of Yi and Rakib suggests what is lacking in Yi or provides any motivation to modify the teachings of Yi so that at least some of the low level data units each contain a plurality of the pieces into which the encapsulated content was divided. Thus, the Examiner has not properly established a *prima facie* 35 USC 103(a) rejection of claim 49 since no proper combination of Yi and Rakib teach or suggest all the claim limitations.

Applicant submits that the Examiner has made a clear error in rejecting claim 49, and that this error is not a matter of interpretation of the claims or prior art teachings, but instead a matter of the existence of a valid factual basis for asserting that the prior art teaches or suggests all the claim limitations.

3. The Examiner has made a clear error in providing a valid factual basis to support a *prima facie* rejection of claim 57.

The Examiner has made a clear error in providing a valid factual basis to support the 35 USC 102(b) rejection of claim 57. In view of this error, Yi fails to disclose all limitations of independent claim 57.

Yi does not disclose at least "dividing the encapsulated content into a plurality of sub-blocks, forming a plurality of pieces, with each piece including one or more sub-blocks, ... and supplying low level data units, at least some of the low level data units each containing a plurality of the pieces," as recited by independent claim 57.

The Examiner identifies the same portions of Yi cited in the rejection of claim 1 as allegedly disclosing the subject matter of claim 57. For similar reasons as discussed above with respect to claim 1, the PDU units do not correspond to low level data units that each contain a plurality of the pieces that include sub-blocks into which the encapsulated content was divided. Thus, the Examiner has failed to establish a *prima facie* 35 U.S.C. 102(b) rejection of claim 57.

Applicant submits that the Examiner has made a clear error in rejecting claim 57, and that this error is not a matter of interpretation of the claims or prior art teachings, but instead a matter of the existence of a valid factual basis for asserting that the prior art discloses all claimed elements arranged as in the claim.


Applicant submits that the rejections of record are clearly not proper in view of the clear deficiency of not properly establishing a *prima facie* rejection of the claims. In view of the above, all of the claims should be in condition for allowance. A formal notice of allowance is thus respectfully requested.

Please apply any charges or credits to deposit account 06-1050, referencing Attorney's Docket No. 04838-077001.

Respectfully submitted,

Date: \_\_\_\_\_

11-1-06

  
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